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EXAMINER

THEIN, MARIA TERESA T

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/665,349

Applicant(s)

HARPER ET AL.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

✓

DETAILED ACTION

Response to Amendment

Applicants' "Amendment E" filed on March 4, 2005 has been considered with the following effect.

Applicants' response to claim 27 has overcome the Examiner's rejection of such claim under 35 USC 112, second paragraph.

Claims 8, 11, 15, 17, and 29 are amended. Claim 21 is cancelled. Claims 1-20 and 22-33 remain pending in this application.

Response to Arguments

Applicant's arguments with respect to claims 1-20 and 22-33 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 6, 8, 11-12, 14-15, 17, 19, 22, 23, and 24-33 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,016,409 to Beard et al.

Regarding claim 1, Beard discloses a method of programming a non-volatile memory unit (col. 7, lines 38-40) in a hard copy output engine comprising: determining a

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geographical area within which the hard copy output engine is to be deployed (This is another code, placed by the manufacturer in a predetermined address in the CRUM memory which identifies the module as belonging to a particular market region, such as a geographical region.... Thus, within an initialization procedure, the distribution board 30 reads a code describing a market region stored in the CRUM memory for a confirmation, col. 8, lines 44-56); determining an address for a consumable supplier (supplier or service organization) appropriate to the geographical area (col. 8, lines 29-34; col. 9, lines 6-9; col. 11, lines 26-32); and programming the electronic address into the non-volatile memory (col. 8, lines 13-17; col. 8, lines 24-34; col. 10, lines 57-65).

The Examiner notes that every computer has a unique address in order to communicate with other computers within a network. The unique address, which is a number or name, identifies the computer uniquely among all the computers on the network, in order for a computer to exchange data and files or send and receive messages with other computers on the network. A computer can only exchange data and files or send and receive messages to another computer if it knows that computer's address. Therefore, it is inherent that Beard provides an electronic address for the supplier or service organization in order to communicate directly to the supplier or service organization from the distribution board 30 through the network.

Regarding claims 4 and 6, Beard discloses programming the non-volatile memory with product descriptors for consumable supplies associated with the hard copy output engine (col. 12, lines 51-67); and the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers, and printers (col. 5, lines 15-19).

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Regarding claim 8, Beard discloses determining that an amount of consumable for the hard copy output engine is less than a threshold amount (col. 12, lines 8-23); extracting an electronic address for a vendor of the consumable from a non-volatile memory included in the hard copy output engine (col. 12, lines 23-28); and initiating communication with the vendor (service organization) using the electronic address; and communicating with the vendor from the hard copy output engine (col. 12, lines 23-28).

Regarding claims 11, 12 and 14, Beard discloses the communicating includes transmitting an electronic message from the hard copy output engine which orders a predetermined quantity of the consumable determined to be present in an amount less than the threshold amount (col. 12, lines 8-23; col. 10, lines 35-65); determining using processing circuitry in response to a sensor in the hard copy output engine sensing that an amount of the consumable is less than a threshold amount (col. 7, line 33-col. 8, line 2; col. 12, lines 8-23); and the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers and printers (col. 5, lines 15-19).

Regarding claim 15, Beard discloses a computer implemented control system for a hard copy output engine, the system comprising: non-volatile memory (CRUM) included in the hard copy output engine and configured to store data representing an electronic address for a supplier of consumables for the hard copy output engine (col. 7, lines 5-14; col. 8, lines 13-17; col. 8, lines 29-34); and processing circuitry (col. 7, line 33-col. 8, line 2) configured to: determine that an amount of a consumable for the hard copy output engine is less than a threshold amount (col. 12, lines 8-23); extract the

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electronic address from the non-volatile memory (col. 12, lines 23-28); and communicate with the supplier using the electronic address (col. 12, lines 23-28).

The Examiner notes that every computer has a unique address in order to communicate with other computers within a network. The unique address, which is a number or name, identifies the computer uniquely among all the computers on the network, in order for a computer to exchange data and files or send and receive messages with other computers on the network. A computer can only exchange data and files or send and receive messages to another computer if it knows that computer's address. Therefore, it is inherent that Beard provides an electronic address for the supplier or service organization in order to communicate directly to the supplier or service organization from the distribution board 30 through the network.

Regarding claims 17, 19, and 22, Beard discloses wherein the processor configures to communicate includes a processor configured to transmit an electronic message ordering a predetermined quantity of the consumable determined to be present in an amount less than the threshold amount (col. 10, lines 35-65; col. 12, lines 8-23); the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers and printers (col. 5, lines 15-19); and wherein the processing circuitry is included in the hard copy output engine (col. 7, line 33-col. 8, line 2).

Regarding claim 23, Beard discloses a method of obtaining consumable suppliers for a hard copy output engine, comprising: determining a geographical area within which the hard copy output engine is to be deployed (This is another code, placed by the manufacturer in a predetermined address in the CRUM memory which

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identifies the module as belonging to a particular market region, such as a geographical region....Thus, within an initialization procedure, the distribution board 30 reads a code describing a market region stored in the CRUM memory for a confirmation, col. 8, lines 44-56); determining an electronic address for a consumables supplier appropriate to the geographical area (col. 8, lines 29-34; col. 9, lines 6-9; col. 11, lines 26-32); storing the electronic address in a non-volatile memory of the hard copy output engine (col. 8, lines 13-17; col. 8, lines 24-34; col. 10, lines 57-65); and proactively initiating communication with the consumables supplier from the hard copy output engine using the stored electronic address responsive to an amount of a consumable for the hard copy output engine being less than a predetermined threshold (col. 10, lines 35-65; col. 12, lines 8-23).

The Examiner notes that every computer has a unique address in order to communicate with other computers within a network. The unique address, which is a number or name, identifies the computer uniquely among all the computers on the network, in order for a computer to exchange data and files or send and receive messages with other computers on the network. A computer can only exchange data and files or send and receive messages to another computer if it knows that computer's address. Therefore, it is inherent that Beard provides an electronic address for the supplier or service organization in order to communicate directly to the supplier or service organization from the distribution board 30 through the network.

Regarding claims 24-25, Beard discloses wherein the determinings and the programming are performed prior to deployment of the hard copy output engine in an

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end user environment (col. 8, lines 24-28; col. 13, lines 39-41; col. 12, lines 51-56); and wherein the programming comprises programming into the non-volatile memory resident within the hard copy output engine (col. 7, lines 5-8; col. 7, lines 23-47; col. 8, lines 7-13).

Regarding claim 26, Beard discloses determining the electronic address corresponding to a geographical area in which the hard copy output engine will be deployed in an end user environment (This is another code, placed by the manufacturer in a predetermined address in the CRUM memory which identifies the module as belonging to a particular market region, such as a geographical region....Thus, within an initialization procedure, the distribution board 30 reads a code describing a market region stored in the CRUM memory for a confirmation, col. 8, lines 44-56; col. 8, lines 29-34; col. 9, lines 6-9; col. 11, lines 26-32); and storing the electronic address within the hard copy output engine prior to deployment of the hard copy output engine (col. 8, lines 13-17; col. 8, lines 24-34; col. 10, lines 57-65).

Regarding claim 27, Beard discloses wherein the non-volatile memory is configured to store the data representing the electronic address prior to deployment of the hard copy output engine in an end user environment (col. 8, lines 24-28; col. 8, lines 44-56; col. 13, lines 39-41; col. 12, lines 51-56).

Regarding claim 28, Beard wherein the determining and the storing are performed prior to deployment of the hard copy output engine in an end user environment (col. 8, lines 24-28; col. 13, lines 39-41; col. 12, lines 51-56).

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Regarding claim 29, Beard discloses wherein the communicating comprises directly sending an electronic message from the hard copy output engine to the vendor without user intervention (col. 8, lines 29-34; col. 9, lines 5-10, col. 10, lines 35-65).

Regarding claim 30, Beard discloses wherein the processing circuitry comprises processing circuitry of the hard copy output engine configured to communicate an electronic message from the hard copy output engine to the supplier without user intervention (col. 8, lines 29-34; col. 9, lines 5-10, col. 10, lines 35-65).

Regarding claim 31, Beard discloses wherein the processing circuitry comprises processing circuitry of the hard copy output engine configured to communicate an electronic message directly to the supplier (col. 8, lines 29-34; col. 9, lines 5-10, col. 10, lines 35-65).

Regarding claim 32, Beard discloses wherein the proactively initiating communication comprises sending an electronic message from the hard copy output engine to the supplier without user intervention (col. 8, lines 29-34; col. 9, lines 5-10, col. 10, lines 35-65).

Regarding claim 33, Beard discloses wherein the proactively initiating communication comprises directly communicating with the supplier using the hard copy output engine (col. 8, lines 29-34; col. 9, lines 5-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3, 7, 9, 10, 16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,016,409 to Beard in view of U.S. Patent No. 5,884,073 to Dent. Beard substantially discloses the claimed invention, however, it does not disclose the universal resource locator. Beard discloses orders for new toner bottles are made directly by distribution board 30 over a network to the service organization (col. 12, lines 23-25).

Dent, on the other hand, teaches a system and method for enhancing manageability of an electronic system (col. 3, lines 3-5). The electronic system enables remote system-level diagnostics through a privately or publicly accessible network in the event of a failure or malfunction (col. 3, lines 5-7). The electronic system may include hard copy equipment (col. 3, lines 9-11). Dent further discloses a non-volatile memory within the electronic system that contains a web address for the service provider and a web browser application program (col. 4, lines 16-19). The web address is the universal resource locator.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and system of Beard, to include the Universal resource locator, as taught by Dent, in order to establish communications with a remotely located service provider via a network (Dent col. 2, lines 40-41).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,016,409 to Beard in view of U.S. Patent No. 6,041,360 to Himmel et al. Beard substantially disclose the claimed invention, however, it does not disclose the

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determining the electronic address is obsolete; determining a revised electronic address; and reprogramming the non-volatile memory with the revised electronic address. Beard discloses a CRUM which are associated with one or more customer-replaceable modules within the apparatus (col. 7, lines 5-8). THE CRUM is in the form of a 2K bit serial EEPROM and is connected to the distribution board 30 using a two-wire serial bus architecture (col. 7, lines 33-38). A non-volatile memory within the CRUM is designed for special applications requiring data storage (col. 7, lines 38-40). Different types of data can be stored in a CRUM, which is read or updated by the distribution board 30 (col. 8, lines 7-9).

Himmel, on the other hand, teaches determining the electronic address (URL) is obsolete (change in web page data can be detected during a request for the web page by the first bookmark; col. 3, lines 5-6); determining a revised electronic address (if redirection of the request to a new URL is detected, the first bookmark is updated to the new URL; col. 3, lines 7-8); and reprogramming the memory with the revised electronic address (col. 2, line 63 – col. 3, line 23; col. 4, lines 31-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Beard, to include the determining of the electronic address is obsolete; determining a revised electronic address; and reprogramming, as taught by Himmel, in order to provide updated bookmarks (collection of URLs) in an easy and automatic way (Himmel col. 13, lines 40-41).

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Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,016,409 to Beard in view of U.S. Patent No. 6,247,044 to Gosling et al. Beard substantially discloses the claimed invention, however, it does not disclose the servlet. Beard discloses sending a request through a network (col. 8, lines 31-32).

Gosling, on the other hand, teaches a determination whether the request required dynamically generated information from a servlet of the client-server network (col. 2, lines 664-67). A servlet corresponding to the request which may be uploaded from a remote server computer (col. 1, line 67 - col. 2, line 2) of the client-server network. The servlet is then executed to obtain generated information corresponding to the request (col. 2, lines 2-4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and system of Beard, to include the servlet, in order to provides an environment that is flexible and extendible (Gosling col. 1, lines 55-57).

Conclusion

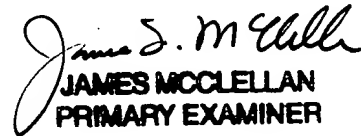
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot
May 27, 2005


JAMES MCCLELLAN
PRIMARY EXAMINER